

**Notice of Allowability**

Application No.

10/661,254

Applicant(s)

MOON ET AL.

Examiner

Art Unit

Arnel C. Lavarias

2872

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/11/06.
2. ☒ The allowed claim(s) is/are 21-77 (renumbered 1-57).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 5. <input type="checkbox"/> Notice of Informal Patent Application                     |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date _____    | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|  | 9. <input type="checkbox"/> Other _____   |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 12/11/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/661031 has been reviewed and is accepted.  
The terminal disclaimer has been recorded.
2. The terminal disclaimer filed on 12/11/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/661082 has been reviewed and is accepted.  
The terminal disclaimer has been recorded.
3. The terminal disclaimer filed on 12/11/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/763995 has been reviewed and is accepted.  
The terminal disclaimer has been recorded.

### ***Response to Arguments***

4. In view of the submission of the terminal disclaimers above, the obviousness-type double patenting rejections in Sections 6-8 of the Office Action dated 8/8/06 are respectfully withdrawn.

***Allowable Subject Matter***

5. Claims 21-77 are allowed.

**REASONS FOR ALLOWANCE**

6. The following is an examiner's statement of reasons for allowance:

Claims 21 and 47 are allowable over the cited art of record for at least the reason that the cited art of record fails to teach or reasonably suggest an optical identification element having a synthesized chemical attached thereto, and a method of synthesizing a chemical on a substrate, as generally set forth in Claims 21 and 47, the element and method including, in combination with the features recited in Claims 21 and 47, an optical substrate being made of a substantially single material and having at least one diffraction grating embedded therein, the grating having a resultant refractive variation within the substantially single material, the grating providing an output signal indicative of a code identifying the item when illuminated by an incident light signal propagating from outside the substrate. Claims 22-46, 48-77 are dependent on Claims 21 and 47, and hence are allowable for at least the same reasons Claims 21 and 47 are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication US 2006/0057729 A1 (Application number 11/206987) to Moon et al.

Moon et al. is being cited to evidence diffraction grating-based identification elements similar to the claims of the instant invention (See for example Claims 1-12, 37, 49 of Moon et al.). However, the instant application is the earlier filed application, and only provisional obviousness-type double patenting rejections would be made with respect to Moon et al. Further, at this point in time, an examination on the merits has not been done on Moon et al., which is the later-filed application. Thus, the instant application is being permitted to issue as a patent without a terminal disclaimer to Moon et al. See specifically MPEP 804, Section I.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arnel C. Lavarias  
Primary Examiner  
Group Art Unit 2872  
1/5/07

  
ARNEL LAVARIAS  
PRIMARY PATENT EXAMINER